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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,390	09/17/2003	Amit Heller	1005-2-01 USP	4423

42698 7590 10/18/2007

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EXAMINER	
NGUYEN, TIEN C	

ART UNIT	PAPER NUMBER
4127	

MAIL DATE	DELIVERY MODE
10/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/664,390	HELLER ET AL.	
	Examiner	Art Unit	
	Tien C. Nguyen	4127	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 September 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *17 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *February 21, 2007*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. The following is a non-final, first office action on the merits. Claims 1-20 are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

In claim 1, it is unclear that how the message is forwarded to the first system since the message already has stored within the first system.

For purposes of this action, it is assumed the message is forwarded from the first system to the second system.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-7, 9, 12, 13, 15, 16, 18 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Uchida et al. (2003/0233322).

As per claim 1, Uchida et al. teaches a method for ordering a service provided over a communications network comprising:

selecting a first service to be provided by a first system to a second system, the service associated with a first code (see paragraph [0079]; via transmitting a service for the billing process which provided by billing system 1. The service associated with the service code);

automatically generating a message comprising the first code, in response to said selection (see paragraph [0008]; "message" via selected "information" to perform billing process. Billing system comprises a service code to process information); and

forwarding the message to the first system from the second system,

wherein a third system in communication with at least the second system causes the second system to generate the message (see paragraph [0144]; via the information is transmitted wherein billing system 3 communicates with the exit point terminal in billing system 2).

As per claim 2, Uchida et al. teaches a method providing the first service from the first system to the second system (see paragraph [0107]; via the service code determining device 12 from billing system 1 provides the determination result to the entry point terminal in billing system 2. The determination result determines whether the cellular phone 20 is allowed to perform the billing process or not. When the billing process is allowed, the entry point terminal provides the service as a billing object).

As per claim 3, Uchida et al. teaches a method wherein the first system is a communication service provider (see paragraph [0060]; via the billing system 1 has a billing server 60 provided on a cellular phone).

As per claim 4, Uchida et al. teaches a method wherein the second system is a wireless mobile communication device (see paragraph [0082]; via the billing system 2 has a billing server 60 provided on a cellular phone mobile terminal 20 communicable through the mobile communication network).

As per claim 5, Uchida et al. teaches a method wherein the first service is downloadable software code for enhancing functionality of the second system (see paragraph [0064]; via the service code can be downloaded from the predetermined site through the mobile communication network).

As per claim 6, Uchida et al. teaches a method wherein the first code identifies the first service to be provided from the first system to the second system (see paragraph [0021]; via the entry point information from the second system can be identified by the service code from the first system).

As per claim 7, Uchida et al. teaches a method wherein the message further comprises user identifying information that provides the first system with information needed for billing a user (see paragraph [0014]; via the information transmitting terminal in billing system 1 comprises billing point notification information transmitting for the billing process).

As per claim 9, Uchida et al. teaches a method wherein the message further comprises a command to provide the first service (see paragraph [0067]; via the billing information transmitter 17 has a function to provide service to the billing information transmitting terminal 30 from the billing system 1).

As per claim 13, Uchida et al. teaches a method wherein the first system comprises a database comprising user account information (see paragraph [0074]; via the billing server 60 in the first system comprises a billing information database 61 to store user account information).

As per claim 15, Uchida et al. discloses an electronic system for ordering a service provided over a communications network comprising:

means for selecting a first service from a plurality of services provided by a service provider, the first service associated with a first code (see paragraph [0079]; via selecting plurality of billing information transmitting terminals 30 within the wireless-communicable area of the cellular phone by a service provider. The service associated with the service code); and

means for automatically generating a message comprising the first code, wherein the message is forwarded to the service provider (see paragraphs [0076] and [0077]; via the billing information is transmitted to the cellular phone 10 (S10) from the service provider. The service associated with the service code).

As per claim 16, Uchida et al. teaches a system wherein the service is provided to a mobile communication device connected to the service provider via a wireless communications network (see paragraphs [0008]; via the billing system use a mobile terminal to provide the service through the mobile communication network and short-range wireless).

As per claim 18, Uchida et al. teaches a system wherein the first code identifies a feature to be downloaded from the service provider to the mobile communication device (see paragraph [0064]; via the service code is download from the predetermined site by accessing through all the keypads of the cellular phone and the mobile communication networks).

As per claim 20, Uchida et al discloses a computer readable medium comprising logic code, wherein execution of the logic code by a processor causes a mobile device to:

establish a connection with a service provider (see paragraph [0074]; via the billing server 60 has a billing information database 61 has a connection with the cellular phone 10 from the service provider);

select a first service from a plurality of services provided by the service provider, the first service being associated with a first code (see paragraph [0079]; via selecting plurality of billing information transmitting terminals 30 within the wireless-communicable area of the cellular phone by a service provider. The service associated with the service code);

construct a text message comprising the first code (see paragraph [0008]; "message" via selected "information" to perform billing process. Billing system comprises a service code to process information), and

forward the text message to the service provider (See paragraph [0061]; via the billing information is forwarded to the cellular phone 10 of the service provider),

wherein the service provider uses the first code for providing the first service to the mobile device (see paragraph [0082]; via the billing system has a billing server 60 provided on a cellular phone mobile terminal 20 communicable through the mobile communication network).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida et al. in view of Examiners Official Notice.

Uchida et al. discloses the claimed invention but is silent regarding the message is automatically generated by way of short message service (SMS) in accordance with instructions from the third system. Examiner takes Official Notice that is old and well known in the art of network communications to transmit messages using short message service (SMS) to communicate with mobile phones, fax machines and IP addresses. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to provide the method of ordering service of Uchida et al. with the short message service transmit message as taught by Examiner's Official Notice, in order to communicate with mobile phones of Uchida et al.

8. Claims 10-11, 14, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida et al. (2003/0233322) in view of Lamb et al. (6,747,970).

As per claim 10, Uchida et al. discloses all the elements of the claimed invention as described in claim 1 above, but fails to explicitly disclose a method wherein the third system is a public kiosk providing one or more services.

Lamb et al. discloses a method wherein the third system is a public kiosk providing one or more services (see column 41, lines 55-59; via a publicly available web kiosk or browner located on a computer system to provide more services to the user).

From this teaching of Lamb et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify a public kiosk web of Uchida et al. to include a public kiosk functions to provide the services as taught by Lamb et al in order to provide the access to the user anywhere in the world. In this manner, user

can access the telecommunications hosting server in a universal manner and the public phone.

As per claim 11, Uchida et al. discloses all the elements of the claimed invention as described in claim 1 above, but fails to explicitly disclose a method wherein the third system is a third party portal providing one or more services.

Lamb et al. discloses a method wherein the third system is a third party portal providing one or more services (see column 16, lines 49-50; via a third party carrier assistance as in conventional system to provide more services for the conference call).

From this teaching of Lamb et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify a third party carrier of Uchida et al. to include a third party carrier functions to provide the services as taught by Lamb et al in order to provide the easily arrangements for the conference calling on the computer network.

As per claim 14, Uchida et al. discloses all the elements of the claimed invention as described in claim 1 above, but fails to explicitly disclose a method wherein the second system comprises application software in communication with server software executed on the third system, wherein the application software in response to communication from the server software generates the message forwarded to the first system.

Lamb et al. discloses a method wherein the second system comprises application software in communication with server software executed on the third system, wherein the application software in response to communication from the server software generates the message forwarded to the first system (see column 26, lines 59-61; via software application that execute on a telecommunications hosting server).

From this teaching of Lamb et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify a software application of Uchida et al. to include a software application's execution to provide the service as taught by Lamb et al in order to provide the user in an easy-to-use software implementation, development of new advanced telecommunications services is made much easier.

As per claim 17, Uchida et al. discloses all the elements of the claimed invention as described in claim 16 above, but fails to explicitly disclose a system wherein the message comprises text.

Lamb et al. discloses a system wherein the message comprises text (see column 53, lines 44-45; via a message comprises textual).

From this teaching of Lamb et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify a message of Uchida et al. to include a textual as taught by Lamb et al in order to provide a mechanism for the user that obtains and reads the message via his or her user agent.

As per claim 19, Uchida et al. discloses all the elements of the claimed invention as described in claim 16 above, but fails to explicitly disclose a system wherein a third device acts as an interface between the mobile communication device and the service provider.

Lamb et al. discloses a system wherein a third device acts as an interface between the mobile communication device and the service provider (see column 1, lines 57-60; via the user telephony devices 105 through 108 are included in User-to-Network interfaces).

From this teaching of Lamb et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify a system of Uchida et al. to

include a telephone device include in User-to-Network interface as taught by Lamb et al in order to provide the supported call connections to the user.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kramer et al. (2003/014007) discloses third party value acquisition for electronic transaction settlement over a network.

Rosen (US 5,703,949) discloses a method for establishing secure communications among processing devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tien C. Nguyen whose telephone number is 571-270-5108. The examiner can normally be reached on Monday-Thursday (8:00am-4:00pm EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynda Jasmin can be reached on 571-270-3033. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TN
10/12/2007

10/15/07
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